

### **REMARKS**

A check in the amount of \$460 for the fees for filing a Request for Continued Examination (\$395) and the terminal disclaimer (\$65) accompanies this amendment. Any fees that may be due in connection with the filing of this paper or with this application may be charged to Deposit Account No. 06-1050. If a Petition for Extension of time is needed, this paper is to be considered such Petition.

Applicants thank the Examiner for taking time to discuss the outstanding Office Action with Applicants' undersigned representative on October 12, 2005. In accordance with that discussion, and in view of the present amendment and remarks, reconsideration of the rejections set forth in the Office Action dated July 13, 2005, is respectfully requested.

Claims 20-31 are pending in this application. Claims 20, 23, 26 and 27 are amended herein. Claims 20 and 23 are amended to incorporate limitations of dependent claims 28 and 29 and claims 26 and 27 are amended to incorporate limitations described below. Claims 28-31 are cancelled herein. No new matter is added.

#### **Claim Objections**

The Examiner objects to the use of the term "device" in the preamble of claim 30. The claim is cancelled herein rendering the objection moot.

#### **Claim Rejections**

##### **35 U.S.C. §112, 1<sup>st</sup> paragraph**

Claim 27 is rejected under 35 U.S.C. §112, 1st paragraph. Applicant has amended claim 27 to recite that the one way valve is so dimensioned as to be guidable in the elongate passage. Applicant submits that the amendment overcomes the rejection under Section 112.

##### **35 U.S.C. §102(b)**

Claims 20-27 are alleged as being anticipated by Andersen *et al.* (U.S. 5,411,552). As discussed in the interview with the examiner, independent claims 20 and 23 have been amended to recite that the device has a construction that completely blocks air flow through the bronchial passageway when the valve is in the closed configuration. Claims 26 and 27 have been amended to recite that the valve has a construction such that no air flow occurs across the valve through

the bronchial passageway when the valve is in the closed configuration. The specification supports such amendments, for example, on page 4, lines 21-22. (“[T]he resilience of the body closes the slit 26 so that no flow can occur.” (Emphasis added).)

The Andersen valve has a construction that would not completely block air flow when the valve is closed. Some air flow would occur across the Andersen valve even when the valve is closed. For example, the Andersen valve is attached to the stent by suturing the valve to the stent. (“The valve 6 is mounted in the stent by means of a suitable number of sutures to form the cardiac valve prosthesis 9 shown in FIG. 2.” See Col. 5, lines 33-35.) In addition, the stent is formed by a pair of folded wire rings that are sutured to one another. (“The two rings are placed on top of each other as will appear from FIG. 1 and they are mutually secured by means of a number of sutures (not shown).” See Col. 5, lines 19-22.) Such sutures create holes that form leak paths for air to pass across the valve even when the valve is closed.

The Love reference (U.S. 4,470,157) also shows a one way valve that is sutured to a stent. Like the Andersen valve, such sutures would create leak paths for air to flow across the valve even when the valve is closed.

Consequently, applicants respectfully submit that the rejection of claims 20-27 should be withdrawn.

### **35 U.S.C. §103(a)**

Claims 28-31 are alleged as being unpatentable over Andersen *et al.* (U.S. 5,411,552) in view of Love (U.S. 4,470,157). Claims 28-31 have been cancelled thereby rendering the rejection moot.

### **Non-statutory double-patenting**

Claims 20-22 and 26 are rejected under obviousness-type double patenting as being unpatentable over claim 1 of U.S. 5,954,766 in view of Andersen *et al.* (U.S. 5,411,552) and over claims 1 and 7 of U.S. 6,632,243 in view of Andersen *et al.* (U.S. 5,411,552). In the interest of advancing this application to allowance, a terminal disclaimer is filed herewith with respect to issued U.S. patents 5,954,766 and 6,632,243. In turn, any obviousness-type double patenting between the instant application and these issued U.S. patents is moot. Applicant reserves the right to cancel the terminal disclaimer if, when the application is deemed allowable, conflicting claims have been cancelled.

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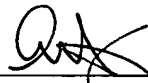
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Request for Continued Exam and Amendment

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the above amendments and remarks, all of the claims should be in condition for allowance. A formal notice to that effect is respectfully solicited.

Respectfully submitted,

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